APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,522	08/02/2001	Rabindranath Dutta	AUS920010168US1	6277

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EXAMINER
NGUYEN, TRI V

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 11/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 August 2001*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *02 August 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some *   c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Specification

1.   The abstract of the disclosure is objected to because of undue length (210

words). The applicant is reminded that the length of the abstract is 150 words of less.

Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

Claims 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention.

Claims 10 recite the limitation "second remuneration" on page 25, line 17. There

is insufficient antecedent basis for this limitation in the claim as a first remuneration is

not aforementioned in the independent claim. It is noticed that claim 10 could fall within

the claim structure of 7/8/9/10 instead of being an independent claim.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this Office

action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public
> use or on sale in this country, more than one year prior to the date of application for patent in the United
> States.

4.   Claims 1, 2,5-12, 14-18, 20-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldhaber et al. (5,855,008).

Regarding claim 1, Goldhaber et al. discloses a method for controlling personal information of a user using a client computer system enabled to be communicatively connected to a plurality of network entities in a network environment, comprising: storing personal information of the user at the client computer system; receiving a request from a first network entity to send the personal information stored at the client to at least one other network entity; enabling the at least one other network entity to be selectable by the user; enabling the personal information to be edited; and sending the edited personal information from the client computer system to each of the selected ones of the at least one other network entity (col 7, lines 11-67; col 12, lines 49-67; col 19, lines 22-67 and col 20, lines 1-58).

Regarding claim 2, Goldhaber et al. discloses the method of claim 1 wherein enabling the personal information to be edited further comprises enabling the personal information to be separately edited for each selected ones of the at least one other network entity (col 12, lines 49-67; cl 13, lines 38-59 and col 18 lines 1-15).

Regarding claim 5, Goldhaber et al. discloses the method of claim 1 further comprising receiving an indication of a remuneration from the first network entity in response to sending the edited personal information to selected ones of the at least one network entity (col 16, lines 12-24).

Regarding claim 6, Goldhaber et al. discloses the method of claim 1 wherein receiving a request further comprises receiving, with the request, a financial incentive to comply with the request (col 7, lines 11-67 and col 12, lines 49-67).

Regarding claim 7, Goldhaber et al. discloses a method of participating in a distribution of personal information of a user in a network environment, comprising: receiving initial personal information from the user over a network; sending a request to the user requesting the user to send the initial personal information of the user to at least one other specified network entity; sending, with the request, an indication of a financial incentive to comply with the request; and receiving a copy of the user personal information sent to the at least one other specified network

entity from the user (col 7, lines 11-67; col 12, lines 49-67; col 19, lines 22-67 and col 20, lines 1-58).

Regarding claim 8, Goldhaber et al. discloses the method of claim 7 further comprising: comparing the received copy of the user personal information with the received initial personal information; and sending a remuneration, based on the comparison, to the user for complying at least in part with the request (col 12, lines 48-67; col 15, lines 38-67 and col 16, lines 1-11).

Regarding claim 9, Goldhaber et al. discloses the method of claim 8 further comprising: receiving a first remuneration from each of the at least one other specified network entity to which the user personal information was sent (col 7, lines 11-67; col 19, lines 21-67 and col 20 lines 1-58).

Regarding claim 10, Goldhaber et al. discloses a method of participating in a distribution of personal information of a user in a network environment, comprising: receiving personal information of the user from the user with an indication of a requesting network entity; and sending a second remuneration to the indicated requesting network entity in response to receiving the personal information (col 7, lines 11-67; col 12, lines 49-67; col 19, lines 21-67 and col 20 lines 1-58).

Claims 11 and 12 describe the system of the method of claim 1; therefore, the prior arts of Goldhaber et al. as set forth above are relied upon to reject claims 11 and 12.

Claims 14 describe the system of the method of claim 7; therefore, the prior arts of Goldhaber et al. as set forth above are relied upon to reject claim 14.

Regarding claim 15, Goldhaber et al. discloses the computer system of claim 14 further comprising: means for comparing the received copy of the user personal information with the received initial personal information; and means for sending a first remuneration, based on the comparison, to the user for complying at least in part with the request (col 7, lines 11-67; col 12, lines 49-67; col 19, lines 22-67 and col 20, lines 1-58).

Regarding claim 16, Goldhaber et al. discloses the computer system of claim 15 further comprising: means for receiving a second remuneration from each of the at least one other specified network entity to which the user personal information was sent (col 7, lines 11-67; col 12, lines 49-67; col 19, lines 22-67 and col 20, lines 1-58).

Regarding claim 17, Goldhaber et al. discloses a computer system enabled to be communicatively connected to a plurality of network entities in a network environment, comprising: means for receiving personal information of a user from the user with an indication of a requesting network entity; and means for sending a remuneration to the indicated requesting network entity in response to the received personal information (col 7, lines 11-67; col 12, lines 49-67; col 19, lines 22-67 and col 20, lines 1-58).

Claim 18 describes a program embodied on a computer readable medium of the method of claim 1; therefore, the prior arts of Goldhaber et al. as set forth above are relied upon to reject claim 18.

Claims 20, 21, 22 and 23 describe a program embodied on a computer readable medium of the system of claims 14, 15, 16 and 17 respectively; therefore, the prior arts of Goldhaber et al. as set forth above are relied upon to reject claims 20, 21, 22 and 23.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 3, 4, 13 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber et al. in view of O'Neil et al. (5,987,440).

Regarding claim 3, Goldhaber et al. discloses the need to prevent unauthorized release of the personal information but does not explicitly mention the use of watermarking the edited personal information before sending the personal information (col 7, lines 11-67). In an analogous art, O'Neil teaches the use of digital signature to track and prevent further distribution of personal information beyond a third party (col 6, lines 29-53 and col 9, lines 27-55). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Goldhaver et al. with the use of digital

signature as taught by O'Neil since it was known in the art that a digital signature or watermark is used to securely deliver electronic documents and information thus preventing non-authorized distribution.

Regarding claim 4, Goldhaber et al. discloses the need to prevent unauthorized release of the personal information but does not explicitly mention the use of uniquely watermarking each one of the separately edited personal information before sending each of the separately edited personal information to each selected ones of the at least one network entity (col 7, lines 11-67). In an analogous art, O'Neil teaches the use of digital signature to track and prevent further distribution of personal information beyond a third party (col 6, lines 29-53 and col 9, lines 27-55). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Goldhaver et al. with the use of digital signature as taught by O'Neil since it was known in the art that a digital signature or watermark is used to securely deliver electronic documents and information thus preventing non-authorized distribution.

Claims 13 and 19 describe a system and a program embodied on a computer readable medium of the method of claim 3; therefore, the prior arts of Goldhaber et al. as set forth above are relied upon to reject claims 13 and 19.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

> A. Karp et al. (20030154171 A1) discloses an apparatus and a method for selling personal information through a trusted third party.
>
> B. Freishtat et al. (6,567,850) discloses a system and a method for determining a revenue from an intermediary from end user interactions involving personal information via the intermediary.
>
> C. Sasaki et al. (6,735,699) discloses a method and system for monitoring us of digital work.

D. Clayton et al. (6,904,417) discloses a policy notice method and system

for regulating the use of individual's personal data.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Tri V. Nguyen whose telephone number is (571) 272-

6965. The examiner can normally be reached on M-F 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

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